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Attorney Docket P1712R1-1D1  
PATENT

12/19/01  
JC960 U.S. PTO

EV 016056206 US Express Mail Number

December 19, 2001 Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOX PATENT APPLICATION  
Assistant Commissioner of Patents  
Washington, D.C. 20231

JC958 U.S. PTO  
10/028410  
12/19/01

**NON-PROVISIONAL APPLICATION TRANSMITTAL UNDER 37 CFR 1.53(b)**

Transmitted herewith for filing is a non-provisional patent application:

Inventor(s) (or Application "Identifier"):

Yves Dubaquier, San Francisco, California  
Paul J. Fielder, Redwood City, California  
Henry B. Lowman, El Granada, California  
Deborah L. Mortensen, Pacifica, California

Title: **PROTEIN VARIANTS**

**1. Type of Application**

- ☐ This application is for an original, non-provisional application.
- ☐ This is a non-provisional application claiming priority to provisional application no. \_\_, filed \_\_, the entire disclosure of which is hereby incorporated by reference.
- ☒ This is a ☐ continuation-in-part ☐ continuation ☒ divisional application claiming priority to application Serial Number 09/477,924, filed January 5, 2000, which is a non-provisional application filed under 37 CFR 1.53(b)(1), claiming priority under 35 USC §119 to provisional application no. 60/170,261 filed December 9, 1999 and provisional application No. 60/115,010 filed January 6, 1999, the entire disclosures of which are hereby incorporated by reference.

**2. Papers Enclosed Which Are Required For Filing Date Under 37 CFR 1.53(b) (Non-provisional )**

43 pages of specification  
2 pages of claims  
1 page(s) of abstract  
12 sheet(s) of drawings  
☒ formal ☐ informal

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**3. Declaration or Oath**

*(for new and CIP applications; also for Cont./Div. where inventor(s) are being added)*  
\_\_\_ An executed declaration of the inventor(s) ☐ is enclosed ☐ will follow.

*(for Cont./Div. where inventorship is the same or inventor(s) being deleted)*  
X A copy of the executed declaration/oath filed in the prior application is enclosed (37 CFR 1.63(d)).

*(for Cont./Div. where inventor(s) being deleted)*  
\_\_\_ A signed statement is attached deleting inventor(s) named in the prior application (see 37 CFR 1.63(d)(2) and 1.33(b)).

**4. Assignment**

*(for new and CIP applications)*  
\_\_\_ An Assignment of the invention to GENENTECH, INC. ☐ is enclosed with attached Recordation Form Cover Sheet ☐ will follow.

*(for cont./div.)*  
X The prior application is assigned of record to Genentech, Inc.

**5. Amendments (for continuation and divisional applications)**

\_\_\_ Cancel in this application original claims \_\_ of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)

\_\_\_ A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

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## 6. Fee Calculation (37 CFR 1.16)

The fee has been calculated as follows:

CLAIMS FOR FEE CALCULATION					
Number Filed		Number Extra		Rate	Basic Fee 37 CFR 1.16(a)
					\$740.00
Total Claims	14	- 20 =	0	X \$18.00	\$0.00
Independent Claims	2	- 3 =	0	X \$80.00	\$0.00
Multiple dependent claim(s), if any				+ \$270.00	\$0.00
Filing Fee Calculation					\$740.00

## 7. Method of Payment of Fees

The Commissioner is hereby authorized to charge Deposit Account No. 07-0630 in the amount of \$740. **A duplicate copy of this transmittal is enclosed.**

## 8. Authorization to Charge Additional Fees

The Commissioner is hereby authorized to charge any additional fees required under 37 CFR §1.16 and 1.17, or credit overpayment to Deposit Account No. 07-0630. **A duplicate copy of this sheet is enclosed.**

**9. Additional Papers Enclosed**

- ☐ Information Disclosure Statement (37 CFR §1.98) w/ PTO-1449 and citations
- ☐ Submission of "Sequence Listing", computer readable copy, certificate re: sequence listing, and/or amendment pertaining thereto for biological invention containing nucleotide and/or amino acid sequence.
- ☐ A new Power of Attorney or authorization of agent.
- ☒ Other: Communication Regarding Grouping of Inventions

**10. Maintenance of Copendency of Prior Application (for continuation and divisional applications)**

*[This item **must** be completed and the necessary papers filed in the prior application if the period set in the prior application has run]*

\_\_\_\_\_ A petition, fee and/or response has been filed to extend the term in the pending prior application until \_\_\_\_\_

\_\_\_\_\_ A copy of the petition for extension of time in the **prior** application is attached.

11. **C rrespondence Address:**

X Address all future communications to:

Attn: Janet E. Hasak

Respectfully submitted,  
GENENTECH, INC.

Date: December 17, 2001

By: Janet E. Hasak  
Janet E. Hasak  
Reg. No. 28,616  
Telephone No. (650) 225-1896



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PATENT TRADEMARK OFFICE

10023410-121901

In re Application of Yves Dubaigue et al. Serial No.: Unassigned Filed: <u>19</u> December 2001 For: PROTEIN VARIANTS	Group Art Unit: Unassigned Examiner: Unassigned  CERTIFICATION UNDER 37 CFR 1.10 <u>EV 016056206 US</u> : Express Mail Number <u>December 19, 2001</u> : Date of Deposit  I hereby certify that this correspondence, consisting of Non-Provisional Application Transmittal Under 37 CFR 1.53(b), specification, formal drawings, Letter and Request to Use Computer-Readable Sequence Listing Under 37 CFR §1.821(e), postcard, Communication Regarding Grouping of Inventions, copy of Declaration, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner of Patents, Washington, D.C. 20231.   Pamela Gavette
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Assistant Commissioner of Patents  
Washington, D.C. 20231

Applicants respectfully request that the Restriction Requirement made in the parent application U.S. Ser. No. 09/477,924 (Paper No. 9 mailed June 14, 2001), which placed peptide, composition, and kit claims in one group (claims 1-6 and 14-20--class 530, subclass 300) and method of treatment claims in a second group (claims 7-13--class 514, subclass 2), be recast to include the kit claims 14-20 together with the method claims 7-13. Because claims 7-20, whether kit or method, relate to pharmaceutical treatment (drug, bio-affecting, and body-treating compositions), they should be considered as a single invention in class 514, subclass 2, and examined together in one application. It is noted that in the enclosed application, original claims 7-20 are now presented as claims 1-14.

Date: December 18, 2001

By: Janet E. Hasak  
Janet E. Hasak  
Reg. No. 28,616  
Telephone No. (650) 225-1896



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